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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/015,559	12/17/2001	Klaus Kramer	52049	6211
26474	7590	02/15/2005	EXAMINER	
KEIL & WEINKAUF 1350 CONNECTICUT AVENUE, N.W. WASHINGTON, DC 20036			WANG, SHENGJUN	
			ART UNIT	PAPER NUMBER
			1617	

DATE MAILED: 02/15/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/015,559

Applicant(s)

KRAMER ET AL.

Examiner

Shengjun Wang

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 31 July 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 3-9 and 11 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 3-9 and 11 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>1/22/04</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Receipt of applicants' amendments and remarks submitted July 13, 2004 is acknowledged. In view of the petition decision issued November 4, 2004, the finality set forth in the office action mailed February 12, 2004 is herein withdrawn.

Claim Rejections 35 U.S.C. 112

1. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

1. Claims 3-9 and 11 are rejected under 35 U.S.C. 112, first paragraph, because the specification, while being enabling for reducing the effect of aging processes or harmful environmental effects on human skin or human hair, does not reasonably provide enablement for preventing the effect of aging processes or harmful environmental effects on human skin or human hair. The specification does not enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention commensurate in scope with these claims. The instant specification fails to provide information that would allow the skilled artisan to practice the instant invention without undue experimentation. Attention is directed to *In re Wands*, 8 USPQ 2d 1400 (CAFC 1988) at 1404 where the court set forth the eight factor to consider when assessing if a disclosure would have required undue experimentation. Citing *Ex parte Forman*, 230 USPQ 546 (BdApl 1986) at 547 the court recited eight factors:

- 1) the quantity of experimentation necessary,
- 2) the amount of direction or guidance provided,

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- 3) the presence of absence of working examples,
- 4) the nature of the invention,
- 5) the state of the prior art,
- 6) the relative skill of those in the art,
- 7) the predictability of the art, and
- 8) the breadth of the claims.

The claims encompass preventing the effect of aging processes or harmful environmental effects on human skin or human hair, and read on stopping aging process. Preventing aging, or stopping aging, is an ultimate goal for the artisans in medicinal art. A lot of effort has been made by the skilled artisans, but with no hard evidence of success. There are no working examples in the application showing a success of preventing the aging of human skin or hair, as herein claimed. The pharmaceutical art is unpredictable, requiring each embodiment to be individually assessed of physiological activity. The instant invention claims a benefit which have never been achieved by a skilled artisan, necessitating an exhaustive search for the embodiments suitable to practice the claimed invention, absent undue experimentation.

Claim Rejections 35 U.S.C. 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

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3. Claims 9 and 11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Eziri et al. (US 4,728,650).

Eziri et al. teaches a 5% ethanol solution of the chroman of formula Ia herein. See, particularly, example 27 in columns 26-27. Note ethanol is deemed to be a cosmetically acceptable carrier. Further, it is well settled that the "intended use," such as those recited herein, of a product or composition will not further limit claims drawn to a product or composition. See, e.g., In re Hack 114 USPQ 161.

Claim Rejections 35 U.S.C. 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 3-9 and 11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Deckner et al. (EP 0 238 302, IDS), in view of Wechter et al. (US 6,048,891, 6,555,575).

6. Deckner et al. teaches a cosmetic, or topical composition comprising 6-hydroxy-2,5,7,8-tetramethyl-chroman-2-carboxylic acid in the amount of 0.01 to 50% as a free radical inhibitor and method of using the same for inhibiting generation of free radical in the skin. See, particularly, pages 2-4, and the claims.

7. Deckner et al. do not teach expressly the employment of 6-hydroxy-2,5,7,8-tetramethyl-chroman-2-ethylenecarboxylic acid.

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8. However, Wechter et al. teaches that carboxylic derivatives of tocopherols are similarly useful as therapeutical agents, particularly, as antioxidants, or free radical inhibitors. See, particularly, columns 6-11, 35-37 in '891. The length of the linker between the carboxyl moiety and chroman may be varied from a bond to five methylenes. See formula I in column 6, wherein m is defined as 0-5. Wechter et al. expressly teaches that 6-hydroxy-2,5,7,8-tetramethyl-chroman-2-ethylenecarboxylic acid is useful as antioxidant agent. See, particularly, the claims in '575.

9. Therefore, it would have been prima facie obvious to a person of ordinary skill in the art, at the time the claimed the invention was made, to use 6-hydroxy-2,5,7,8-tetramethyl-chroman-2-ethylenecarboxylic acid in Deckner's cosmetic composition and use the same for protecting skin.

10. A person of ordinary skill in the art would have been motivated to use 6-hydroxy-2,5,7,8-tetramethyl-chroman-2-ethylenecarboxylic acid in Deckner's cosmetic composition and use the same for protecting skin because carboxylic derivatives of tocopherols in general, and 6-hydroxy-2,5,7,8-tetramethyl-chroman-2-ethylenecarboxylic acid in particular, are known to be similarly useful as antioxidants, or free radical inhibitors.

Response to the Arguments

Applicants' amendments and remarks submitted July 31, 2004 have been fully considered, but are moot in view of the new ground rejections set forth above.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Shengjun Wang whose telephone number is (571) 272-0632. The examiner can normally be reached on Monday to Friday from 7:00 am to 3:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Sreeni Padmanabhan, can be reached on (571) 272-0629. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

SHENGJUN WANG
PRIMARY EXAMINER

Shengjun Wang
Primary Examiner
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